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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.1258-00000

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Application Number

10/702,438

Filed

November 7, 2003

First Named Inventor

Raquel DE CARVALHO

Art Unit

1616

Examiner

S.D. GOLLAMUDI

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.☒ attorney or agent of record.
Registration number 39,064☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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Typed or printed name

202-408-4454

Telephone number

June 18, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief panel review of the rejections set forth in the final Office Action mailed January 18, 2007, and maintained in the Advisory Action mailed April 12, 2007. Applicant asserts that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal under 37 C.F.R. § 41.31; (3) this request is being filed prior to the filing of an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with guidelines set forth in the O.G. Notice of July 12, 2005. No amendments are being filed herewith. The period for reply has been extended two months to June 18, 2007, by the petition for extension of time and fee payment filed herewith.

REMARKS

A. Status Of The Claims

Claims 1, 2, and 4-25 are now pending in this application and stand rejected.

B. Rejection over Bolich under §102(e): All Claimed Elements are not Taught.

The Examiner maintains the rejection of claims 1, 2, 4-10, and 12-25 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,635,240 to Bolich et al. ("Bolich"). Applicants respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found . . . in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). See also M.P.E.P. § 2131. If a reference does not disclose a specific embodiment which satisfies all of the claim limitations, it will nonetheless describe the claimed invention within the meaning of § 102(b) if it "clearly and unequivocally . . . [directs] those skilled in the art to [the claimed invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis added).

Bolich, according to the Examiner, discloses aerosol hair styling compositions comprising specified amounts of a water soluble polyalkylene glycol (polyol), a liquid carrier, and a propellant. Final Office Action at 3. The Examiner also alleges that Bolich discloses an optional additional styling agent, such as an anionic polysaccharide, and an optional gelling agent that helps provide for improved hair hold, for example, an anionic crosslinked carboxylic acid polymer such as CARBOPOL 934. *Id.* at 3-4. Nevertheless, Applicants respectfully submit that Bolich has not disclosed "each and every element as set forth" in the present claims.

To support his position, the Examiner relies on the test from *In re Petering*, 301 F.2d 676,682 (C.C.P.A. 1962), as set forth in M.P.E.P. §2131.02, specifically that if one of ordinary skill can "at once envisage" a species from a claimed genus, then the species is anticipated.

The Examiner then states, with respect to Bolich's disclosure of the polysaccharides, "the species are sufficiently limited for one to immediately envisage the use of each polysaccharide respectively." Final Office Action at 7. Applicant disagrees. The *Petering* case related to a species "envisaged" from a generic chemical formula. The Examiner is taking that holding and stretching it too far. Specifically, Bolich discloses compositions which require a polyalkylene glycol, a liquid carrier, and a propellant, and which "may further comprise one or more optional styling polymers." Col. 6, ll. 47-48 (emphasis added). Of these optional styling polymers, anionic polysaccharides are listed as a subgenus at the top of col. 7. However, Bolich does not disclose any species of anionic polysaccharide, even though he does disclose a list of suitable optional *cationic* polysaccharides at col. 7, lines 5-21, and other optional styling polymers at col. 7, lines 22-67. In Applicant's view, mere mention of the anionic polysaccharide subgenus does not constitute a disclosure sufficient to anticipate the claimed composition.

To further support his position that the disclosure of anionic polysaccharides is somehow anticipatory, the Examiner points to the anionic gelling agent, CARBOPOL 934, a cross-linked carboxylic acid polymer used in Examples XV and XVI of Bolich, apparently to show the general use of an anionic polymer in Bolich's exemplified compositions. Final Office Action at 8. However, relying on an optional anionic *gelling agent* to take the place of the required anionic *fixing polymer* in the composition of Bolich amounts to improper picking and choosing to try to achieve the present invention, not to anticipation. Furthermore, Examples XV and XVI, the only place CARBOPOL 934 is disclosed in Bolich, are mousse compositions, and do not meet the limitations of the presently claimed amounts of either the propellant, the polyol, or the anionic fixing polymer. Thus, for these additional reasons, Bolich fails to teach or even suggest a composition containing all of the presently claimed elements within the claimed range.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. The § 102(e) rejection should accordingly be withdrawn.

C. Rejection over Birkel under §102(b): All Claimed Elements are not Taught.

The Examiner maintains the rejection of claims 1, 2, and 4-25 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2001/0003584 to Birkel et al. ("Birkel").

As discussed for Bolich above, Birkel has disclosed "each and every element" of the presently claimed cosmetic composition. Again, to make his rejection, the Examiner appears to have selectively chosen aspects of Birkel and fashioned a grouping to read on the present invention. One of ordinary skill in the art would have to choose to add a co-solvent and then select among branched or unbranched hydrocarbons, which Birkel characterizes as "especially suitable" as co-solvents, or ethylene glycol, glycerol, or propylene glycol, which are "especially

preferred" as water-soluble solvents. Birkel at [0027]. Birkel discloses that the hair composition can exist in various application forms, such as a lotion, non-aerosol spray, aerosol spray, foam, gels, etc. Birkel at [0004]. Birkel provides no guidance for selecting which optional co-solvent or solvent, if any, the artisan should choose, for which application form. Moreover, not one of the 10 examples in Birkel shows the use of any of these solvents or co-solvents. Therefore, the picking and choosing of this optional ingredient by the Examiner is improper and Birkel cannot and does not anticipate.

The Examiner points to Example 2 as disclosing a hair spray comprising a propellant and filled in an aerosol can. Office Action at 13. While every embodiment need not be exemplified in order to anticipate a claim, the examples do serve to illustrate the subject matter of the invention. In examples 2, 3, and 4, the 100 grams of the "effective ingredient containing solution" containing 10.00 grams of water is diluted when it is filled in an aerosol can in a ratio of 45:55 with DME as propellant. The result is a composition that is 4.5 % by weight of water, based on the total weight of the aerosol composition. This fails to meet the limitation in claim 1 of the present invention, "comprising at least 10% by weight of water, based on the total weight of the aerosol composition." Therefore, while Birkel provides guidance for an aerosol composition, it fails to teach or even suggest a composition containing all of the presently claimed elements within the claimed range.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. The § 102(b) rejection should accordingly be withdrawn.

D. Double Patenting Rejections

The Examiner has maintained the nonstatutory obviousness-type double patenting rejections of the present claims over

- (1) claims 1-29 of copending Application No. 10/796,016 alone;
- (2) claims 1-29 of copending Application No. 10/796,016 in combination with U.S. Patent No. 5,639,448 (US '448);
- (3) claims 1-25 of copending Application No. 11/124,229 in combination with US '448;
- (4) claims 1-20 of copending Application No. 11/220,586 in combination with US '448,
- (5) claims 23-50 of copending Application No. 10/279,036 in view of US '448, and
- (6) claims 20-36 of copending Application No. 10/479,170 in view of US '448

Applicant files herewith a Terminal Disclaimer to obviate rejections (1)-(4). The other two rejections are discussed below.

1. Double Patenting Rejection over Copending Application No. 10/279,036 in view of U.S. Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1, 2, and 4-25 on the ground of nonstatutory obviousness-type double patenting over claims 23-50 of copending Application No. 10/279,036 ("the '036 application") in view of U.S. Patent No. 5,639,448 ("US '448"). Final Office Action at 20. Applicants respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art references, when combined, must teach or suggest all the claim limitations of the rejected claims. M.P.E.P. § 2143. Applicants contend that the Examiner has failed to establish a *prima facie* case of obviousness at least because the '036 application fails to teach or suggest all of the claim limitations, and a person skilled in the art would not have been motivated to combine the '036 application with US '448 to produce the claimed invention.

The Examiner admits that the '036 application claims do not include at least 15% of a polyol. Final Office Action at 21. According to the Examiner, it would have been obvious to include polyols in the presently claimed concentration because "US '448 teaches the instant polyols are *conventionally* utilized as solvents and carriers." *Id.* (emphasis in original). *Id.* The Examiner has provided no evidence of motivation to combine US '448 with the claims of the '036 application. US '448 merely states that other cosmetic additives can be incorporated in its claimed composition. US '448 at col. 13, ll. 56-59. One possible additive is an organic solvent, which can be added to solubilize compounds that are not sufficiently soluble in water. *Id.* at col. 13, ll. 64-67. Among these additives, polyols are "suitable solvents" for the composition that "can be present in an amount from about 1% to about 75%." *Id.* at col. 14, ll. 3-10. The Examiner states that polyol solvents are *conventionally* utilized in hair compositions as carriers and solvents. Final Office Action at 21 (emphasis in original). However, such indication that polyols may be required for the solubility of particular compounds is not tantamount to conventional use, especially when there is no suggestion in the '036 application that solubility of any particular compounds is a concern.

Also, Applicants maintain, for reasons of record, that the Examiner's citation of *In re Aller* is inappropriate. The Examiner fails to explain how the conclusions of *In re Aller*, which were made in reference to a chemical process with defined ingredients, can be extended to the choice of ingredients, as well as the concentration of ingredients, for a composition as presently claimed. Moreover, the Examiner has provided no evidence that modification of the '036 claims

by the addition of a polyol in the claimed amount would result from the "routine efforts of the artisan." There is simply no sufficient suggestion or motivation to combine.

For at least these reasons, Applicants respectfully submit that the '036 application claims and present claims are not obvious modifications of one another. Therefore, the rejection should be withdrawn.

2. Double Patenting Rejection over Copending Application No. 10/479,170 in view of U.S. Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1-25 on the ground of nonstatutory obviousness-type double patenting over claims 20-36 of copending Application No. 10/479,170 ("the '170 application") in view of US '448 . Office Action at 25. Applicants respectfully traverse for the reasons stated above.

The Examiner admits that the '170 application fails to claim a polyol in the composition, and again relies on US '448 to teach the use of a polyol in the presently claimed amount. Final Office Action at 26. Applicants submit that the '448 patent provides no motivation to one of ordinary skill in the art to use a polyol in the presently claimed amount in the claims copending in the '170 application. Accordingly, Applicants request withdrawal of the rejection.

CONCLUSION

In view of the above arguments, Applicants submit that the present claims are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 18, 2007

By: 

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